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ART UNIT	PAPER NUMBER
2166	

DATE MAILED:
09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____3____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 27, 2001* _____ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-16* _____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-16* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

DETAILED ACTION

1.   Claims 1-16 are presented for examination. Applicant's application was abandoned on

6/15/2001. Applicant's filed a petition to revive the application on 7/27/2001. The petition to

revive was granted on 8/16/2001. Applicant filed an amendment on 7/27/2001. After careful

review of Applicant's arguments, the Examiner finds Applicant's arguments non-persuasive and

the rejection of claims 1-16 based on 35 USC 102 and 35 USC 103 is maintained.

Response to Arguments

2.   With respect to Applicant's arguments directed to objections to the specification, in light

of Applicant's amendment to the specification, the Examiner withdraws the objection to the

specification. However, the objection to hyperlinks in the specification is maintained. Although

Applicant's argument that the hyperlinks are merely used as an example to better illustrate

Applicant's proposed invention, the hyperlinks might refer to existing web pages and if such,

constitute an improper incorporation by reference. Therefore, the objection to hyperlinks in the

specification is maintained.

3.   With respect to Applicant's arguments directed to claims 1, 5 and 13, Applicant argues

that the d'Eon reference does not disclose the claimed methods that provide information,

determine reach and frequency, or collect information in response to a user viewing an

advertisement. The Examiner disagrees. Applicant characterizes the d'Eon reference as disclosing

a user clicking on an advertisement. The process of clicking an advertisement involves the process

of a user viewing the advertisement. Therefore, d'Eon disclose the claimed invention of claims 1, 5, and 13 and therefore, Applicant's arguments are deemed to be nonpersuasive. Furthermore, since Applicant's arguments to the rejection of claims 2, 3, 6, and 7 are based on Applicant's arguments to claims 1, 5, and 13 and since the Examiner found Applicant's arguments to claims 1, 5, and 13 to be nonpersuausive, the Examiner finds Applicant's arguments to claims 2, 3, 6, and 7 to be nonpersuasive.

4.   With respect to claim 9, Applicant argues that there was no motivation to combine d'Eon and Marsh. The Examiner disagrees. The motivation to combine was cited from the secondary reference explicitly or Marsh. Applicant further argues that the combination d'Eon and Marsh fail to disclose a system that measures the number of online users presented with advertisements. However, d'Eon discloses a system to provide information, determine reach and frequency, or collect information in response to a user viewing an advertisement. Furthermore, d'Eon discloses Applicant's panel computer that includes second storage as explained in detail in the rejection of claim 9 below. Therefore, all the limitations of claim 9 are disclosed by d'Eon and Marsh and Applicant's arguments are deemed nonpersuasive.

Oath/Declaration

5.   The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an

address at which an inventor customarily receives his or her mail and may be either a home

or business address. The post office address should include the ZIP Code designation.

Specification

6.   The disclosure is objected to because of the following informalities: .

a. The specification contains numerous references to hyperlinks. For example

page 11, line 5 and line 26, page 25, lines 13-16 and page 28 contain references to

hyperlinks. The use of hyperlinks and/or other forms of browser-executable code are

impermissible and require deletion. The attempt to incorporate subject matter into the patent

application by reference to a hyperlink and/or other forms of browser-executable code is

considered to be an improper incorporation by reference. See MPEP 608.01(p), paragraph I

regarding incorporation by reference.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United
States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8.   Claims 1-3, 5-7, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by d'Eon et al., Pat. No. 6,006,197 (hereinafter d'Eon).

With respect to claim 1, d'Eon discloses a method of providing information on advertisements viewed (see abstract) comprising:

a) instrumenting a viewing device with an instrumentation program (i.e. tracker module 16)(col. 4, lines 2-10);

b) receiving information at the viewing device, the information including advertisements (i.e. banner advertisement)(col. 4, lines 23-34); and

c) collecting information identifying the advertisements received (i.e. a network path name is invoked to hyperlink the user to the Web page associated with the advertisement)(col. 4, lines 57-65).

With respect to claim 2, d'Eon discloses the method as recited by claim 1 wherein a sample of a population of viewing devices are instrumented with the instrumentation program (see Fig. 1 and col. 4, line 2-10).

With respect to claim 3, d'Eon discloses the method as recited by claim 1 wherein the advertisements are banner images (i.e. banner advertisement)(col. 4, lines 23-34).

With respect to claim 5, d'Eon discloses a method of determining the reach and frequency of view of an advertisement (see abstract) comprising:

a) instrumenting a viewing device with an instrumentation program (i.e. tracker module 16)(col. 4, lines 2-10);

b) receiving information at the viewing device, the information including advertisements (i.e. banner advertisement)(col. 4, lines 23-34); and

c) collecting information identifying the advertisements received (i.e. a network path name is invoked to hyperlink the user to the Web page associated with the advertisement)(col. 4, lines 57-65).

With respect to claim 6, d'Eon discloses the method as recited by claim 5 wherein a sample of a population of viewing devices are instrumented with the instrumentation program (i.e. banner advertisement)(col. 4, lines 23-34).

With respect to claim 7, d'Eon discloses the method as recited by claim 5 wherein the advertisements are banner images program (see Fig. 1 and col. 4, line 2-10).

With respect to claim 13, d'Eon discloses a method of collecting information regarding advertisements viewed by a client computer communicating with a distributed network (see Fig. 1 and abstract), the method comprising the steps of:

a) receiving an advertising image from the distributed network at the client computer (i.e. banner advertisement)(col. 4, lines 23-34);

b) deriving a unique identifier identifying the advertising message (i.e. a network path name is invoked to hyperlink the user to the Web page associated with the advertisement)(col. 4, lines 57-65);

c) reporting the unique identifier to an analysis engine (i.e. tracker module 16)(col. 5, lines 35-50).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over d'Eon as applied to claim 1 above, and further in view of Kaiserswerth et al., Pat. No. 5,684,954 (hereinafter Kaiserswerth).

With respect to claim 4, D'Eon discloses the method as recited by claim 1 wherein the collected information comprises a banner image 102 URL (col. 4, lines 57-67).

d'Eon does not explicitly disclose

the collected information includes a checksum and a length.

However, Kaiserswerth discloses a system for extracting connection information in a

communication network (see abstract and col. 1, lines 9-12). Kaiserswerth discloses collecting

information on incoming messages including a checksum and length (see Table 1 and col. 5, lines

16-40). It would have been obvious to one of ordinary skill in the art at the time of Applicant's

invention to include the collected information includes a checksum and a length within the d'Eon

system to provide fast and reliable processing of addressing information in a networked

environment (col. 1, lines 9-12 and col. 2, lines 1-6 and lines 56-67).

11.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over d'Eon as applied to

claim 5 above, and further in view of Kaiserswerth.

With respect to claim 8, D'Eon discloses the method as recited by claim 5 wherein the

collected information comprises a banner image 102 URL (col. 4, lines 57-67).

d'Eon does not explicitly disclose

the collected information includes a checksum and a length.

However, Kaiserswerth discloses a system for extracting connection information in a

communication network (see abstract and col. 1, lines 9-12). Kaiserswerth discloses collecting

information on incoming messages including a checksum and length (see Table 1 and col. 5, lines

16-40). It would have been obvious to one of ordinary skill in the art at the time of Applicant's

invention to include the collected information includes a checksum and a length within the d'Eon

system to provide fast and reliable processing of addressing information in a networked

environment (col. 1, lines 9-12 and col. 2, lines 1-6 and lines 56-67).

12.   Claims 9-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over d'Eon

in view of Marsh et al., Pat. No. 5,848,397(hereinafter Marsh).

With respect to claim 9, d'Eon discloses a panel computer comprising a stored program

for instrumenting the computer to report information regarding the advertising images viewed on

the computer (i.e. tracker software 16)(see Fig. 1 and abstract), the computer comprising:

c) a second storage area storing the second stored program, the second stored program

when executed causing the computer to collect statistics on advertisements retrieved from the

distributed network and viewed on the computer, the second stored program collecting

information regarding the advertisements viewed (i.e. a network path name is invoked to

hyperlink the user to the Web page associated with the advertisement)(col. 4, lines 57-65).

d'Eon does not explicitly disclose

a) a first port coupled in communication with the distributed network.

However, Marsh discloses a first port coupled in communication with the distributed

network (col. 5, lines 36-48). The purpose of the connection is to allow the client computer to

communicate with other computer systems (col. 5, lines 36-38). It would have been obvious to

one of ordinary skill in the art at the time of Applicant's invention to include a first port coupled

in communication with the distributed network within the d'Eon system for the motivation stated

above.

d'Eon does not explicitly disclose

b) a first storage area storing the first stored program, the first stored program when

executed causing the computer to allow user controlled access to the distributed network.

However, the Examiner interprets this limitation to be a browser program. The Examiner

takes official notice that it was well known in the computer arts to use browser programs

provided by Internet Service Providers (e.g. CompuServe, AOL) to access web sites on the

Internet. The programs allowed authorized users access to the Internet. It would have been

obvious to one of ordinary skill in the art at the time of Applicant's invention to include a first

storage area storing the first stored program, the first stored program when executed causing the

computer to allow user controlled access to the distributed network within the d'Eon system in

order to access web sites on the Internet

With respect to claim 10, d'Eon discloses the panel computer as cited by claim 9 wherein

the advertisements are banner images (see Fig. 1 and col. 4, line 2-10) .

With respect to claim 12, d'Eon discloses the panel computer as recited by claim 9

wherein the distributed network is the Internet (see Fig. 1, unit 14).

13.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over d'Eon and Marsh as applied to claim 9 above, and further in view of Kaiserswerth.

        With respect to claim 11, d'Eon discloses the panel computer as recited by claim 9 wherein the collected information comprises a banner image 102 URL (col. 4, lines 57-67). d'Eon does not explicitly disclose

        the collected information includes a checksum and a length.

        However, Kaiserswerth discloses a system for extracting connection information in a communication network (see abstract and col. 1, lines 9-12). Kaiserswerth discloses collecting information on incoming messages including a checksum and length (see Table 1 and col. 5, lines 16-40). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the collected information includes a checksum and a length within the d'Eon system to provide fast and reliable processing of addressing information in a networked environment (col. 1, lines 9-12 and col. 2, lines 1-6 and lines 56-67).

14.   Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over d'Eon as applied to claim 13 above, and further in view of Kaiserswerth.

With respect to claim 14, d'Eon does not explicitly discloses the method as recited by claim 13 wherein the unique identifier comprises a checksum.

However, Kaiserswerth discloses a system for extracting connection information in a communication network (see abstract and col. 1, lines 9-12). Kaiserswerth discloses collecting information on incoming messages including a checksum and length (see Table 1 and col. 5, lines 16-40). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method as recited by claim 13 wherein the unique identifier comprises a checksum within the d'Eon system to provide fast and reliable processing of addressing information in a networked environment (col. 1, lines 9-12 and col. 2, lines 1-6 and lines 56-67).

With respect to claim 15, d'Eon does not explicitly disclose the method as recited by claim 13 wherein the unique identifier comprises a checksum and the length of the advertising image.

However, Kaiserswerth discloses a system for extracting connection information in a communication network (see abstract and col. 1, lines 9-12). Kaiserswerth discloses collecting information on incoming messages including a checksum and length (see Table 1 and col. 5, lines 16-40). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method as recited by claim 13 wherein the unique identifier comprises a checksum and the length of the advertising image within the d'Eon system to provide fast and reliable processing of addressing information in a networked environment (col. 1, lines 9-12 and col. 2, lines 1-6 and lines 56-67).

With respect to claim 16, d'Eon discloses the method as recited by claim 13 wherein the

step of reporting to the analysis engine is accomplished by transmitting a message over the

distributed network from the client to a server, the message including the unique identifier (i.e.

when a user clicks on an advertisement, identifying information, such as an image of the banner

and a unique visitor identification number is sent to tracker module 16 (see col. 5, lines 34-49).

Since the tracker module may reside on the advertisement home Web site, the information is sent

from the client to a server)(see col. 4, lines 2-10).

Conclusion

15.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date

of this final action.

16.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The

examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In

addition, the examiner can be reached on alternate Fridays.

        If any attempt to reached the examiner by telephone is unsuccessful, the examiner's

supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax telephone number for this

group is (703) 305-0040.

Alexander Kalinowski

9/25/2000

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